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REMARKS

The amendments and remarks herein are presented in favor of patentability and place this application in condition of allowance. Such action is respectfully requested.

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In response to Examiner's 35 U.S.C. 102(b) rejection over Chao, U.S. Patent No. 6,109,747, Applicant has canceled claims 10-13. Thus, the 102(b) rejection in view of Chao is now moot.

15       Examiner has also rejected claims 1-9 and 14-26 under 35 U.S.C. 103(a) as being unpatentable over Chao (6,109,747). The 103(a) rejection is respectfully traversed.

35 U.S.C. § 103(a) states,

20       [a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that **the subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

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(Emphasis added.)

35       In applying § 102(b), MPEP § 706.02(a) instructs, "[i]n a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The

5 modification must be one which would have been obvious to one of  
ordinary skill in the art at the time the invention was made."  
MPEP §706.02(a) (page 700-21).

Examiner states that Chao discloses a grip extension 24  
10 having a flange 25 downward with a magnet 26 whereas the claimed  
invention claims a grip extension having a flange upward with a  
magnet. Examiner further reasoned that the difference between  
the claimed invention and Chao is the flange, i.e., oriented  
upward versus downward, respectively. Examiner concluded that  
15 although Chao does not teach the exact configuration as claimed  
by the Applicant, the configuration differences are considered  
obvious design choices and are not patentable unless unobvious  
or unexpected results are obtained from these changes. Examiner  
further noted, "[i]t appears that these changes produce no  
20 functional differences and therefore would have been obvious."

Applicant respectfully disagrees with the reasoning of the  
Examiner as to the obviousness of Applicant's invention. First,  
the novel feature of applicant's invention is the mounting of  
25 auxiliary eyeglasses on conventional eyeglasses with the sole  
support being magnets oriented to provide maximum magnetic  
attraction to hold the auxiliary eyeglasses on the conventional  
eyeglasses.

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The possibility of mounting auxiliary frames on primary eyeglasses with the sole support being provided by mutually attractive magnets was overlooked and is not taught by Chao. Chao states, “[t]he primary objective of the present invention 10 is to provide an auxiliary frame for attaching typical spectacle frame having no magnets therein.” Col. 1, lines 23-25. The stated objective of Chao teaches away from attachment of auxiliary to primary frame via magnets alone, as is done by the Applicant.

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Chao specifically requires the use of a mechanical support member (arm 24) to hook the auxiliary frame onto the primary frame. In fact, the Chao reference essentially teaches that magnets alone are insufficient to hold the auxiliary eyeglasses 20 on conventional frames because Chao only teaches that the use of magnets “may further solidly secure the auxiliary frame 20 to the primary frame 10.” The phrase “further secure” underscores the importance of arm 24 extending over the bridge 11 and flange 25 protruding downward, in creating a hook-type connection. 25 This teaches away from the Applicant’s under and upward connection that does not depend on any hooks between the two frames and solely uses magnets to hold the two frames together.

5       Further, Chao's description of the main distinguishing  
characteristic of his invention can be easily seen to be  
teaching away from the Applicant's invention:

10      An auxiliary frame 20 for supporting auxiliary lenses  
includes a bridge 21 and two extensions 22 disposed in  
the side portions and extended rearward for engaging  
over the bridge 11 and the studs 12 of the primary  
frame 10 respectively. The bridge 21 includes an arm  
24 extended rearward. The extensions 22 and the arm 24  
15      each includes a rear end having a flange 23, 25  
dependent downward.

Col. 2, lines 49-54.

20      In addition, Chao specifically states,

25      It is to be noted that the flanges 23, 25 of the  
extensions 22 and of the arm 24 are extended downward  
for engaging with the studs 12 and the bridge 11 such  
that the flanges 23, 25 themselves form a hook means  
for securing the auxiliary frame 20 to the primary  
frame 10. In addition, the magnets 14, 26 are disposed  
laterally such that the flanges 23, 25 may further be  
stably and solidly attracted and retained in place.

30      Col. 2, lines 62-67.

Thus, it is abundantly clear that Chao never thought that  
magnets alone would be sufficient to hold auxiliary eyeglasses  
on conventional eyeglass frames.

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Chao does not stop there and provides even more disclosure  
that teaches further away from the Applicant's invention:

5 It is further to be noted that the flanges 23, 25 may  
also be used to hook to the typical eyeglasses having  
no magnets engaged therein, such that the auxiliary  
frame 20 may be attached to any of the typical  
eyeglasses. Particularly, when the typical eyeglasses  
10 are made of metal or other magnetic materials, the  
magnets 26 of the auxiliary frame 20 may also be used  
for attracting the typical eyeglasses and may also be  
used for solidly securing the auxiliary frame to the  
typical eyeglasses.

15 It is also to be noted that with only the arm 24 and  
the magnet 26 therein, the auxiliary frame 20 may also  
be solidly secured to the primary frame 10. Without  
20 the arm 24 and without the magnets 26, the auxiliary  
frame 20 may also be secured to the primary frame 10  
by engaging the flanges 23 with the studs 12. The  
provision of the magnets 26 and 14 may further solidly  
secure the auxiliary frame 20 to the primary frame 10.

25 Col. 3, lines 1-17.

It is very clear from the Chao disclosure that the  
construction described in Chao is limited to a construction  
where the main force keeping the primary frame 10 and the  
30 auxiliary frame 20 attached is the metallic flanges 23, 25 of  
the primary frame's arms hooking over and around the nose bridge  
11 of the auxiliary frame. In Chao, magnets 24, 26 only  
“further” secure the two frames together. Thus, Chao does not  
describe, and certainly does not suggest the attachment of the  
35 two frames via magnets alone.

Essentially, not only does Chao fail to teach or suggest  
the Applicant's construction, Chao instead teaches and suggests

5 a contrary construction, i.e., of using mechanical support as a primary force along with magnets, which provide further support. Therefore, if Chao's invention was patentable, so to should be the Applicant's invention.

10 The Examiner does not explain what motivation one would have to make the changes considering the repeated emphasis on mechanical support provided by the hooking of arm 24 of auxiliary frame 20 onto the bridge 11 of the primary frame 10. The Board in Ex Parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) expressly held, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of non-obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification to make the necessary changes in the referenced device." (Emphasis added)

25 Applicant can find no motivation in the Chao reference to use a flange that mounts the primary frame bridge from the bottom, using only magnets as the force holding the two frames together. Such motivation is particularly lacking in view of Chao's repeated emphasis on the structural support provided by

5 hooking between arm 24 and bridge 11. Thus, Chao actually  
teaches away from and is contrary to the invention disclosed and  
claimed by applicant. This fact is clear and is convincing  
evidence of nonobviousness. Furthermore, the holding in Chicago  
Rawhide also clearly requires a finding of non-obviousness in  
10 this case.

One additional reason why Applicant's invention is novel  
and non-obvious in view of Chao is that the bottom-mounting  
design, permissible because of the unique construction disclosed  
15 and claimed by the Applicant, is cosmetically superior to top  
mounted magnetic eyewear, such as disclosed in Chao.

The reason it is cosmetically superior is because top  
mounted magnetic eyewear disclosed in Chao exposes the arm 24 to  
20 view when the auxiliary frame is attached to the primary frame.  
The metallic arm of the auxiliary frame in Chao is typically  
considered to be visually unattractive by users because it  
extends over and around the nose bridge of the primary frame and  
is in full view.

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The present invention solves this cosmetic problem through  
a structural solution by having only magnets holding the  
auxiliary frame and the primary frame together, and by having  
the rearward-extending arm go under and behind the nose bridge,

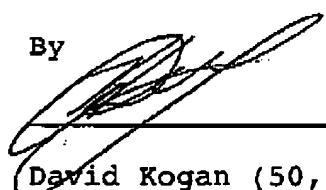
5 instead of over and behind the nose bridge, as in Chao. The rearward-extending arm in the Applicant's invention is practically not visible, as compared to Chao, when the auxiliary lenses are attached to the primary lenses, so the problem of the rearward arm being visually unappealing is solved. This  
10 structural solution to a cosmetic problem is very important in the eyewear industry because sales are largely based on appearance and fashion. Such a structural solution to a pressing problem in the fashion industry should be patentable.

15 Accordingly, applicant respectfully submits that the pending claims clearly describe new and novel features, which are not shown, taught, or remotely suggested by Chao, and should be entitled to patent protection. Indeed the prior references teach away from the arrangement disclosed, described and claimed  
20 by Applicant. Thus, the 103(a) rejection of the pending claims over Chao is improper and should be withdrawn.

Respectfully Submitted,

TROJAN LAW OFFICES

25 By



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